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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, NHON D

ART UNIT PAPER NUMBER

2174

DATE MAILED: 06/10/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/943,863

Applicant(s)

STAELIN ET AL.

Examiner

Nhon (Gary) D Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said behavior" in line 7. There is insufficient antecedent basis for this limitation in the claim because "said behavior" could be either "associated behaviors" or "predetermined behavior" in lines 4 and 6, respectively.

Claim 4 recites the limitation "said second menu item" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Arcuri et al. ("Arcuri", US 6,121,968).

As per independent claim 1, Arcuri teaches a method of providing a menu in relation to a predetermined document, the method comprising the steps of:

- creating a main menu (fig. 2A);
- creating a list of associated behaviors (110 of fig. 2B; e.g. Outline, Ruler, Document Map, Footnotes, Comments, Full Screen);
- defining a document ("Bloatware White Paper.doc" of fig. 2A and 2B, for example);
- defining a predetermined behavior; associating said document with said behavior (110 of fig. 2B; e.g. Outline, Ruler, Document Map, Footnotes, Comments, Full Screen); specifying said behavior on said list of associated behaviors; and said document comprises a pointer to said list of associated behaviors (col. 8, lines 35-61).

As per claim 2, which is dependent on claim 1, Arcuri teaches the main menu comprises a first menu item (100 of fig. 2A; View is a menu item).

As per claim 3, which is dependent on claim 1, Arcuri teaches the step of defining a predetermined behavior further comprises the step of defining an associated menu fragment wherein said menu fragment comprises a predetermined menu item (fig. 2C; col. 8, lines 50-53).

As per claim 4, which is dependent on claim 2, Arcuri teaches the method further comprises the step of merging said second menu item with said main menu (col. 8, lines 57-61).

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As per independent claim 5, Arcuri teaches a method of providing a menu in relation to a predetermined document, the method comprising the steps of:

defining a main menu (fig. 2A);

defining a document ("Bloatware White Paper.doc" of fig. 2A and 2B, for example);

defining a predetermined behavior, said predetermined behavior comprising an associated menu fragment (fig. 2C; col. 8, lines 50-53);

associating said document with said predetermined behavior; merging said associated menu fragment with said main menu; and displaying a merged menu comprised of said main menu and said associated menu fragment (col. 8, lines 35-61; examples of menu fragments are Outline, Ruler, Document Map, Footnotes, Comments, Full Screen of fig. 2B).

As per claim 6, which is dependent on claim 5, Arcuri teaches the main menu comprises a predetermined menu item (100 of fig. 2A; View is a menu item).

As per claim 7, which is dependent on claim 5, Arcuri teaches the step of associating said document with said predetermined behavior comprises the step of creating a list of behaviors associated with said document (fig. 2B; col. 8, lines 29-35).

As per claim 8, which is dependent on claim 7, Arcuri teaches the step of defining said document comprises the step of defining a pointer to said list of behaviors (by selecting the behaviors in menu 110 of fig. 2C when opening the "Bloatware White Paper.doc" document).

As per independent claim 9, it is rejected under the same rationale as claim 5.

As per claims 10 and 11, which are dependent on claims 9 and 10 respectively, Arcuri teaches the controller is further configured to and generate a signal representative of a merged menu comprising said menu fragment and said main menu, wherein said controller is further configured to output said signal representative of said merged menu to said display device (col. 8, line 50 – col. 9, line 10).

As per claims 12 and 13, these claims are rejected under the same rationale as claim 1.

As per claim 14, which is dependent on claim 12, Arcuri teaches the user input comprises selection of a displayed menu item (col. 8, lines 10-12).

As per claims 15, 16, they are rejected under the same rationale as claim 12.

As per claim 17, it is rejected under the same rationale as claim 13.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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US 5706458 A to Koppolu, Srinivasa R. discloses Method and system for merging menus of application programs.

US 6624831 B1 to Shahine, Omar H. et al. discloses System and process for generating a dynamically adjustable toolbar.

US 6469719 B1 to Kino, Hisayuki et al. discloses Graphical user interface apparatus with improved layout of menu items.

Inquiries

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon (Gary) D Nguyen whose telephone number is 703-305-8318. The examiner can normally be reached on Monday - Friday from 8 AM to 5:30 PM with every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L Kincaid can be reached on 703-308-0640. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Nhon (Gary) Nguyen

May 20, 2004

Kristine Kincaid
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